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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,453	04/12/2001	Evelyn Jennifer Lin Paulsen	174PUS06106	3297

23543 7590 12/23/2003

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,453

Applicant(s)

PAULSEN ET AL.

Examiner

Sam Chuan C. Yao

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art (APA) in view of Krebs et al (US 5,880,167) for reasons of record set forth in in Paper No. 11 numbered paragraph 2.

Response to Arguments

3. Applicant's arguments filed on 11-12-03 have been fully considered but they are not persuasive.

Applicant argues on 4 full paragraphs 3-4 that the adhesive composition of the present invention has characteristics which are "*surprising and unexpected*" as shown in Tables 2-3. It is respectfully submitted that, the recited claims are not commensurate with the data presented in Tables 1-3. Objective evidence of non-obviousness must be commensurate in scope with the claims. Here the claims were of **much broader scope** than those presented in examples 1-2. For instance, MDI and TDI were used in conjunction with PPG-based were used to form polyurethane prepolymers (Table 1). Moreover, as illustrated in example 1, specific Part A and Part B compositions, using the MDI/TDI based prepolymers in Table 1, are used to form various adhesives. There is no adequate basis for reasonably concluding that a great number and variety of

polyurethane prepolymers as a class included in the recited claims would behave in the same manner as those illustrated in Tables 1-3.

Counsel argues on page 5 last full paragraph that *"although there may exist a prepolymer reaction product composition in the prior art that fulfills the perfect prepolymer and free isocyanate monomer limitations does not necessarily negate nonobviousness. There must also be a suggestion or direction in the art to use such composition to the exclusion of all the other, equally low free isocyanate monomer-containing prepolymer compositions that do not contain the required amount of perfect prepolymer."* (page 5 full paragraph 5). The presence of other options does not necessarily render the used of a commercially available polyurethane prepolymer disclosed by the APA any less obvious. It is respectfully submitted that, one in the art would have been motivated to use a polyurethane prepolymer with very low (<0.1 wt%) residual monomeric isocyanate disclosed by the APA, not only because, the polyurethane prepolymer is readily available (a commercially available prepolymer), but also because the polyurethane prepolymer has several beneficial characteristics such as OSHA and DOT nonhazardous, easy processing, low viscosity, long pot life, improved high-temperature performance, etc. (see an attached description of a Airthane® Polyurethane Prepolymers. As for Counsel's argument regarding the alleged surprising advantages not being disclosed by the prior art references, an invention may be obvious for a different reason than that addressed by the inventor. e.g., In re Dillon, 16 USPQ 2d 1887 (Fed.Cir 1990). The fact that applicant has recognized another advantage which would flow naturally from the teachings of the prior art cannot be the

basis for patentability when the differences would otherwise be obvious. In re Obiaya, 227 USPQ 58 (PTO Bd Appl 1985).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff H Aftergut can be reached on (703) 308-2069. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7115.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2058.


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
12-15-03